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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LARS SEVERINSSON

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035
Technology Center 3600

Decided: May 19, 2010

Before ALLEN R. MACDONALD, *Vice Chief Administrative Patent Judge*,
and LINDA E. HORNER and KEN B. BARRETT, *Administrative Patent
Judges*.

HORNER, *Administrative Patent Judge*

DECISION ON APPEAL

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

STATEMENT OF THE CASE

Lars Severinsson (Appellant)¹ seeks our review under 35 U.S.C. § 134 of the Examiner's final Office action of September 14, 2007 in reissue application 09/710,962. The reissue application seeks to reissue U.S. Patent 5,833,035, issued November 10, 1998 ("the '035 Patent") from application 08/817,769, filed April 27, 1997 ("the '769 Application"). The reissue application contains claims 29-32, all of which have been rejected by the Examiner. Claims 1-28 have been canceled. Br. 2. We have jurisdiction under 35 U.S.C. § 6(b).

SUMMARY OF DECISION

We AFFIRM.

THE INVENTION

Appellant's claimed invention is a disc brake caliper. '035 Patent, col. 1, l. 5. Claim 29, reproduced below, is representative of the subject matter on appeal.

29. A disc brake caliper system comprising a disc brake caliper including

a housing (1) to be arranged astraddle of a vehicle brake disc,

two thrust sleeves (8), which are connected to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which are axially movable in the housing at a distance from each other,

a cross bar (9) connecting the two thrust sleeves, and

¹ The real party in interest identified in the Brief is Haldex Brake Products AB of Landskrona, Sweden. Br. 2.

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

a lever (17) for transmitting a brake force from a brake cylinder (4) attached to the disc brake caliper, to the cross bar,

characterized in that a mechanism including at least the thrust sleeves (8), the cross bar (9) and the lever (17) is held together as a unit in the absence of the housing (1)

and further characterized in that bearing tappets (20), parallel with the cross bar (9), are fixedly connected to the inside of the disc brake caliper and in that the lever (17), besides an arm (18) for actuation by the brake cylinder (4), comprises a curved wedge (19), having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19'') -- with greater radius than the inner cylindrical surface -- in engagement with an inner cylindrical surface of the cross bar.

THE REJECTION

Appellant seeks review of the Examiner's rejection of claims 29-32 under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based.

ISSUE

The Examiner found that reissue claim 29 is broadened because it omits the limitation of the cover as a part of a self sustained unit in a brake mechanism and further found that during prosecution of the application that led to the patent now in reissue: (1) the claims included "two thrust sleeves (8) ... arranged on the cover for disposal in the housing"; (2) the Specification described the cover and the rest of the mechanism held together as a unit, (3) Appellant identified the novel feature of the claimed

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

invention as “the housing and cover members...structured with the entire braking unit carried by the cover independently from the housing to be inserted as a unit”, and (4) Appellant presented arguments during prosecution of a prior reissue application of the ‘035 Patent that the cover was a necessary limitation to distinguish over the prior art. Ans. 3-6.

Appellant agrees that the reissue claims on appeal are broader than the patented claims because the reissue claims do not require a cover. Br. 8. Appellant contends that “the cover does not relate to surrendered subject matter, as the cover itself was not added and no arguments about the presence of the cover itself were made in an effort to overcome a prior art rejection.” *Id.* Rather, Appellant contends that Appellant consistently argued for patentability on the basis that the brake mechanism is “held together as a unit” and that any statements made during prosecution concerning the cover were “merely incidental.” Br. 9-10. Appellant adds that the presence of the cover could not have been relied upon for patentability since the prior art clearly disclosed a brake system having a housing and a cover. Br. 10. Thus, Appellant argues that the recapture rejection fails part two of the *In re Clement* three-part test.

The issue presented by this appeal is:

Does the broader aspect of reissue claims 29-32, viz. the absence of a limitation that the two thrust sleeves are *arranged on the cover* for disposal in the housing, relate to subject matter surrendered in the original

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

prosecution of the ‘035 Patent, such that the reissue claims are barred by the rule against recapture?

FINDINGS OF FACT

We find that the following enumerated findings are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Appellant filed the ‘769 Application on April 27, 1997 including prosecution claims 1-11, of which claim 1 was the sole independent claim.
2. Prosecution claim 1 as originally filed recited:
 1. A disc brake caliper, comprising a housing (1) to be arranged astraddle of a vehicle brake disc, a cover (2) attached to the housing, two thrust sleeves (8), which are connected to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which are axially movable in the housing at a distance from each other, a cross bar (9) connecting the two thrust sleeves, and a lever (17) for transmitting a brake force from a brake cylinder (4), attached to the caliper, to the cross bar, characterized in that bearing tappets (20), parallel with the cross bar (9), are fixedly connected to the inside of the cover (2) and in that the lever (17), besides an arm (18) for actuation by the brake cylinder (4), comprises a curved wedge (19), having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19'') - with greater radius than the inner cylindrical surface - in engagement with an inner

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

cylindrical surface in the cross bar.

3. The Examiner issued an Office action on November 14, 1997 rejecting claims 1-4, 7, 10, and 11 and objecting to claims 5, 6, 8, and 9. The Examiner rejected claim 7 under 35 U.S.C. § 112, second paragraph, as being indefinite, and rejected claims 1-4, 10, and 11 under 35 U.S.C. § 102(e) as being anticipated by US Patent 5,433,298 to Antony.
4. Appellant filed a Response to the Office Action on January 29, 1998 in which Appellant amended prosecution claim 1 as follows:
 1. (Amended) [A] An interconnected disc brake caliper assembly ready for insertion into [comprising] a housing (1), comprising in combination: housing structure for straddling [to be arranged astraddle of] a vehicle brake disc, a cover (2) [attached] for attachment to the housing substantially parallel to the brake disc carrying said assembly which further comprises two thrust sleeves (8), which are [connected] connectable to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which sleeves are axially movable and arranged on the cover for disposal in the housing at a distance from each other, a cross bar (9) [connecting] encompassing the two thrust sleeves, and a lever (17) for transmitting a brake force from a brake cylinder (4) to said crossbar, when attached to the caliper assembly, [to the cross bar, characterized in that] bearing tappets (20) [,] arranged parallel with the cross bar (9) [, are] fixedly connected to the inside of the cover (2) and wherein [in that] the lever (17) [, besides] comprises an arm (18) for actuation by the brake cylinder (4) [, comprises] and a curved wedge (19) [,] having an inner

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19") [-] with greater radius than the inner cylindrical surface [-] in engagement with an [inner] inwardly directed cylindrical surface in the cross bar.

Response to Office Action, dated Jan. 29, 1998 pp. 1-2.

5. In response to the rejection of claim 1 as anticipated by Antony, the Appellant stated:

Parent claim 1 is amended to better structurally define applicant's novel feature wherein the housing and cover members are structured with the entire braking unit carried by the cover independently from the housing (page 3, lines 22-26) to be inserted as a unit.

Thus, to overcome the 35 USC 102 rejection the claimed structure is now more distinctly defined over Antony, et al., which discloses no such modular unit.

Response to Office Action, dated Jan. 29, 1998, pp. 6-7.

6. Subsequent to the Response, the Examiner and Appellant held an Examiner Interview during which the Appellant agreed to correct certain § 112 issues in the claims. Interview Summary, dated May 27, 1998.
7. The Examiner then issued a Notice of Allowance, which included an Examiner amendment of some of the claims, including an amendment to prosecution claim 1 as shown below:

1. (Twice Amended) An interconnected disc brake caliper assembly ready for attachment to a brake cylinder (4) [insertion into a housing (1)], comprising in

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

combination: a housing [structure] for straddling a vehicle brake disc, a cover (2) attached [for attachment] to the housing substantially parallel to the brake disc [carrying said assembly] which further comprises two thrust sleeves (8), which are connectable to a brake pad holder (6) provided with a brake pad (5) for braking engagement with the brake disc and which sleeves are axially movable and arranged on the cover for disposal in the housing at a distance from each other, a cross bar (9) encompassing the two thrust sleeves, and a lever (17) for transmitting a brake force from a brake cylinder (4) to said crossbar, [when attached to the caliper assembly,] bearing tappets (20) arranged parallel with the cross bar (9) fixedly connected to the inside of the cover (2) and wherein the lever (17) comprises an arm (18) for actuation by the brake cylinder (4) and a curved wedge (19) having an inner cylindrical surface (19') in engagement with outer cylindrical surfaces of the bearing tappets and an outer cylindrical surface (19'') with greater radius than the inner cylindrical surface in engagement with an inwardly directed cylindrical surface in the cross bar.

Notice of Allowability, dated May 27, 1998, p. 2.

8. The UPSTO then issued the ‘035 Patent from the ‘769 Application on November 10, 1998.
9. Appellant’s Specification refers to the cover and braking mechanism, in combination, as “a unit”:

The cover and the cross bar may according to the invention be resiliently connected by means of screws extending through holes in the cross bar and attached to the cover, a compression spring being arranged between the head of each screw and a spring sleeve bearing

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

against the cross bar.

By this design a return force for the cross bar and accordingly for the thrust sleeves is obtained, but *the cover and the rest of the mechanism are also held together as a unit even in the absence of the housing, which accordingly may be manufactured separately.*

‘035 Patent, col. 2, ll. 23-32 (emphasis added).

10. Appellant’s Specification does not describe the braking mechanism alone being capable of being held together as a unit in the absence of the housing.

PRINCIPLES OF LAW

What has become known as the “recapture rule,” prevents a patentee from regaining through a reissue patent subject matter that the patentee surrendered in an effort to obtain allowance of claims in the patent sought to be reissued. *In re Clement*, 131 F.3d 1464, 1468 (Fed. Cir. 1997).

The Federal Circuit’s opinion in *Clement* discusses a three-step test for analyzing recapture.

Step 1 involves a determination of “whether and in what ‘aspect’ any claims sought to be reissued are broader than the patent claims.” 131 F.3d at 1468. The Federal Circuit reasoned that a reissue application claim deleting a limitation or element from a patent claim is broader as to that limitation’s or element’s aspect. *Id.*

Step 2 involves a determination of “whether the broader aspects of the reissue [application] claims relate to surrendered subject matter.” 131 F.3d at 1468-69. In this respect, review of arguments and/or amendments during

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

the prosecution history of the application, which matured into the patent sought to be reissued, is appropriate. In reviewing the prosecution history, the Federal Circuit observed that “[d]eliberately canceling or amending a claim in an effort to overcome a [prior art] reference strongly suggests that the Applicant admits that the scope of the claim before cancellation or amendment is unpatentable.” 131 F.3d at 1469. *See also Hester Indus. v. Stein, Inc.*, 142 F.3d 1472, 1481 (Fed. Cir. 1998) (“an amendment to overcome a prior art rejection evidences an admission that the claim was not patentable” (citations omitted)).

Step 3 of the *Clement* test is applied when the broadening relates to surrendered subject matter and involves a determination whether the surrendered subject matter has crept into the reissue application claim. 131 F.3d at 1469.

As to the second part of the *Clement* test, the Federal Circuit recently stated:

[A] patentee is only entitled to a reissue patent for broader claims when the patentee claimed “less than he had a right to claim in the patent” through “error without any deceptive intent [],” not through deliberate amendments or arguments designed to convince an examiner to allow the claims. 35 U.S.C. § 251; *see also Medtronic, Inc. v. Guidant Corp.*, 465 F.3d 1360, 1372–73 (Fed. Cir. 2006) (“[T]he deliberate surrender of a claim to certain subject matter during the original prosecution of the application for a patent ‘made in an effort to overcome a prior art rejection’ is not such ‘error’ as will allow the patentee to recapture that subject matter in a reissue.” (quoting *Clement*, 131 F.3d at 1468–69)); *Haliczer v. United*

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

States, [] 356 F.2d 541, 545 ([Ct. Cl.] 1966) (“[D]eliberate withdrawal or amendment of claims . . . to obtain a patent cannot be said to involve the inadvertence or mistake contemplated by 35 U.S.C. § 251, and is not an error of the kind which will justify the granting of a reissue patent which includes the matter withdrawn.”). Moreover, the court prohibits recapture based on principles of equity. An applicant’s surrender of subject matter places “competitors and the public . . . on notice . . . and may have [caused them] to rely on the consequent limitations on claim scope.” *MBO*, 474 F.3d at 1331; *see also Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1384 (Fed. Cir. 1998) (“[T]he ‘recapture rule’ ... ensur[es] the ability of the public to rely on a patent’s public record.”); *Mentor Corp. v. Coloplast, Inc.*, 998 F.2d 992, 993 (Fed. Cir. 1993) (“[T]he reissue statute cannot be construed in such a way that competitors, properly relying on prosecution history, become patent infringers when they do so.”).

MBO Labs., Inc. v. Becton, Dickinson & Co., No. 2008-1288, 2010 WL 1427547, at *5 (Fed. Cir. Apr. 12, 2010).

To determine whether a patentee surrendered subject matter, we ask “whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee’s amendment or argument was to overcome prior art and secure the patent.” *Kim v. ConAgra Foods, Inc.*, 465 F.3d 1312, 1323 (Fed. Cir. 2006). If the patentee surrendered by argument, he must clearly and unmistakably argue that his invention does not cover certain subject matter to overcome an examiner’s rejection based on prior art.

Id. at *6 (citations omitted).

ANALYSIS

In this case, Appellant does not dispute the Examiner’s analysis as to the first and third steps of the recapture analysis. The Examiner found that

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

claim 29 omits claiming the cover as a part of a self sustained unit in a brake mechanism. Ans. 3. Appellant agrees that reissue claims 29-32 are broader than the claims in the ‘035 Patent because the reissue claims do not require a cover. Br. 8. The question before us is whether an objective observer viewing the prosecution history would conclude that the purpose of the patentee’s amendment and argument during the original prosecution was to overcome prior art and secure the patent such that the Appellant surrendered a disc brake caliper assembly in which the thrust sleeves are not required to be arranged on the cover as a unit.

An objective observer looking at the prosecution history would see that Appellant amended the original prosecution claims to add the limitation that the two thrust sleeves are arranged on the cover for disposal in the housing in order to overcome an anticipation rejection based on Antony (Facts 1-4). The objective observer would further see that Appellant argued that the prosecution claims, as amended, distinguished the claimed invention from the brake disc caliper of Antony, because the claimed invention required the entire braking unit to be carried by the cover independently from the housing so that the modular cover and braking unit assembly could be inserted into the housing as a unit (Fact 5). The objective observer would surmise that the Examiner relied on this claim amendment and argument to allow the claimed disc brake caliper over the prior art (Facts 6-8). The objective observer would also see from reading Appellant’s Specification, that Appellant described the modular “unit” as including both the cover and

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

the braking mechanism and that the Specification does not describe the braking mechanism alone being capable of being held together as a unit in the absence of the housing (Facts 9 and 10). As such, we find that an objective observer viewing the prosecution history would conclude that the purpose of Appellant's amendment and argument during the original prosecution was to overcome prior art and secure the patent such that the Appellant surrendered a disc brake caliper assembly in which the thrust sleeves are not required to be arranged on the cover as a unit. In other words, Appellant surrendered a brake disc caliper including a brake mechanism that can be held together as a unit without the inclusion of a cover.

The Appellant argues that there was no deliberate surrender during the original prosecution, arguing that “[l]ike the applicant in *Medtronic* [v. *Guidant Corp.*, 465 F.3d 1360 (Fed. Cir. 2006)], the present Applicant’s statements made during prosecution concerning the cover were merely incidental.” Br. 10. We see no analogy between the facts in *Medtronic* and the facts before us in the present appeal.

In *Medtronic*, the court held that while certain claims at issue covered an “unconditional embodiment” as filed, and were amended so that they no longer covered that embodiment², there was no deliberate surrender of subject matter to obtain allowance of the claims. *Id.* at 1375. The court

² In *Medtronic*, there was no prior art rejection, or any rejection at all, of the pertinent claims and the claims were amended in an examiner’s amendment to make “minor wording changes.” 465 F.3d at 1374-75.

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

based this holding on substantial evidence showing that neither the examiner nor the prosecuting attorney considered the original claims to cover the unconditional embodiment, and thus there was no deliberate surrender of the unconditional embodiment by the amendments made during prosecution. *Id.* The court found that “[t]he fact that [the prosecuting attorney] thought the claims were directed to the conditional embodiment alone is demonstrated by his correspondence with the inventor and with the examiner.” *Id.* The court further found that “[t]he fact that the examiner thought that the claim was to the conditional embodiment alone is demonstrated by the examiner’s amendment he made to add ‘minor wording changes.’” *Id.*

The facts before us are different from those before the court in *Medtronic* in several significant respects. In *Medtronic*, the examiner made some “minor wording changes” to the claims that, unbeknownst to the examiner or prosecuting attorney, narrowed the claims to exclude an unconditional embodiment, whereas in this case, Appellant made deliberate amendments to the claims in response to a prior art rejection (Facts 3-5). Specifically, original prosecution claim 1 simply recited “a cover” as one component of the disc brake caliper, and Appellant amended this claim, in response to the prior art rejection, to recite “[a]n interconnected disc brake caliper assembly” and added that the “two thrust sleeves (8), … are arranged on the cover for disposal in the housing” (Fact 4). Further, the correspondence between the prosecuting attorney and the Examiner in this case evinces a deliberate surrender of subject matter, unlike in *Medtronic*.

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

where no such correspondence existed. In particular, the Appellant in this case specifically argued that the amended claim distinguished over the prior art because it recited a cover and a braking unit that could be inserted into the housing as a modular unit (Fact 5). Appellant has not presented us with any persuasive objective evidence to rebut the strong suggestion from the prosecution history that Appellant's claim amendments and arguments were made to overcome the prior art rejection and thus acted as a surrender of subject matter.

Appellant argued that the presence of the cover could not have been asserted to contribute to patentability because "the prior art clearly disclosed a brake system having a housing and a cover." Br. 10. A similar argument was recently discounted by our reviewing court. *See MBO*, 2010 WL 1427547, at *8. In *MBO*, MBO argued that it did not surrender a guard body moving forward to cover a fixed needle because its references to a retractable needle were not an attempt to overcome prior art or persuade the examiner to allow its claims based on retraction, but were merely a concession that the prior art disclosed a retractable needle. *Id.* at *8. The Federal Circuit noted that even if the retractable needle was known in prior art, the fact that MBO relied on it to distinguish over other prior art still amounts to surrender:

MBO misunderstands the rationale behind the rule against recapture. The fact that some of the prior art may have disclosed a retractable needle cannot save MBO's reliance on its retractable needle to distinguish other prior art. "The public's reliance interest provides a justification for the

Appeal 2008-005060
Application 09/710,962
Patent 5,833,035

recapture rule that is independent of the likelihood that the surrendered territory was already covered by prior art or otherwise unpatentable.” *MBO Labs., Inc. v. Becton, Dickinson & Co.*, 474 F.3d [1323,] 1332 [(Fed. Cir. 2007)].

Id. As such, we find that Appellant surrendered the subject matter that Appellant is now trying to reclaim in reissue claims 29-32.

CONCLUSION

The broader aspect of reissue claims 29-32, viz. the absence of a limitation that the two thrust sleeves are *arranged on the cover* for disposal in the housing, relates to subject matter surrendered in the original prosecution of the ‘035 Patent, such that the reissue claims are barred by the rule against recapture.

DECISION

The decision of the Examiner to reject claims 29-32 is AFFIRMED.

No time period for taking any subsequent action in connection with this appeal may be extended. *See* 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

nhl

ST. ONGE STEWARD JOHNSTON & REENS, LLC
986 BEDFORD STREET
STAMFORD CT 06905-5619